



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Application No. 09/658,612

Inventor: Nelson

Confirm. No.: 3385

Date Filed: September 8, 2000

Title: Telephone Accessory for Generating Conversation
Utterances to a Remote Listener in Response to a
Quiet Selection

PATENT APPLICATION

Art Unit: 2643

Examiner: R. Barnie

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Michelle McAnern Calavita

Signature Date: September 2, 2005

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Dear Sir:

These Remarks are in response to the Advisory Action mailed August 17, 2005 (hereafter, "Advisory Action") and the Final Office Action mailed May 11, 2005 (hereafter, "Final Office Action"). Claims 1-7 and 9-13 were pending in the Application prior to the outstanding Final Office Action and the outstanding Advisory Action. The Final Office Action and the Advisory Action rejected claims 1-7 and 9-13.

The Final Office Action rejected claims 1-2, 3, 5-7 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Slotte*. The Final Office Action rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Slotte* in view of *Yamashita* or *Bremer* and further in view of *Levy* or *Saito*. The

Final Office Action rejected claims 9-11 under 35 U.S.C. § 103(a) as being unpatentable over *Slotte* in view of *Yamashita* or *Bremer* and further in view of *Zahavi*. The Final Office Action rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Slotte* in view of *Zahavi* and further in view of *Yamashita* or *Bremer*.

The present invention discloses a system for a telephone that generates audible utterances for a remote listener in response to a quiet selection in an ongoing conversation. Independent claims 1 and 7 disclose systems for a telephone, according to which the internal conversation element derives from an *ongoing* conversation between at least two *live people*. Claim 1 discloses that a user interacts with the device and the conversation element to generate an audible utterance in real time. Claim 7 discloses that a user interacts with the device and the conversation elements to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone. Claim 13 discloses that the plurality of internal conversation elements represents audible utterances to be transmitted to a remote listener in an *ongoing* conversation between at least two *live people*. Claim 13 further discloses that a user selects a mechanical device from the plurality of mechanical devices and in response the processor ends a quiet mode and accepts audible utterances from a party local to the telephone and transmits the accepted audible utterances through the telephone in real time.

None of the cited references, considered singly or in combination, discloses or suggests the features of the claimed invention. *Slotte* discloses an invention designed for a person that wishes to transmit call-related information along with a telephone call (col. 2, lines 30-36). The passage cited in the Advisory Action (col. 10) discloses as an example, a situation where B is in a meeting and has set his mobile telephone into silent mode according to a manual embodiment. Contrary to the suggestion of the Advisory Action (p. 2, para. 2), no live user is necessarily present at the receiving end during the operation of the invention, and no conversation taking place between two people in real time is disclosed, let alone a conversation taking place between two people in real time in which audible utterances are generated. *Slotte* can therefore in no way be equated with the current invention.

By the same token, *Bremer* discloses a remote device that includes a silent alert allowing the device to signal the user of an incoming call without an audible alert. (Abstract and col. 1, lines 56-58). The device further includes a key to accept the call into a *nonactive* state, after which a

prerecorded message is generated from memory and played for the calling party to inform the caller that the user is occupied but will answer the call shortly. (Abstract and col. 1, lines 58-60) The passage cited in the Advisory Action (col. 3, lines 29-35) discloses that the user accepts the call into an active call state upon generating a signal to controller. According to *Bremer*, operation of the invention terminates once the user (recipient of the call) enters the activate call state, i.e., initiates a real-time phone conversation with the caller (Abstract and col. 1, lines 62-67). No conversation taking place between two people in real time is disclosed, let alone a conversation taking place between two people in real time in which audible utterances are generated. *Bremer* can therefore in no way be equated with the current invention.

Contrary to the suggestions of The Final Office Action and the Advisory Action, the quiet mode key and the control key are elements of the *same* mechanical device (see fig. 2) and therefore, in contrast to claim 1, make no disclosure relating to a processor configured to accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone in response to user interaction with the *second* mechanical device associated with ending a quiet mode. Similarly, in contrast to claim 7, make no disclosure relating to a processor configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone in response to user interaction with a *second* mechanical device associated with ending a quiet mode.

Similarly, *Yamashita* discloses a portable communication apparatus which can stop the alert indicating the occurrence of an incoming call while holding the incoming call so that the calling party does not disconnect the call. (Abstract and col. 2, lines 7-10). The invention is directed to a caller who is on hold. (Abstract and col. 10, lines 25-54). *Yamashita* makes no disclosure relating to a live user at the receiving end during the operation of the invention, and no conversation taking place between two people in real time is disclosed, let alone a conversation taking place between two people in real time in which audible utterances are generated.

Similarly, with regard to claim 13, *Zahavi* discloses a system and method which allows a cellular phone user to communicate with a caller when the user is unable to speak aloud. a second telecommunication device a request for setting up a telephone connection. (Abstract). The method comprises the steps of establishing a wireless communication link between a wireless terminal user and a second party and selectively activating at the wireless terminal the transmission of at least one

audible message for receipt by the second party, wherein the audible message is responsive to a message transmitted by the second party. (Abstract) *Zahavi* makes no disclosure relating to a processor configured, in response to user interaction with a *plurality* of mechanical devices, to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Therefore none of the cited references, considered singly or in combination, discloses the limitations of independent claims 1 regarding (a) a mechanical device *associated with a conversation element*; (b) a memory, coupled to the mechanical device, for storing an internal conversation element representing an *audible utterance* for a remote listener in an *ongoing conversation*; (c) a processor, coupled to the memory and the mechanical device, for *generating the audible utterance in response to a user interaction* with the mechanical device and the conversation element; and (d) wherein the processor, in response to user interaction with the *second* mechanical device, is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Similarly, none of the cited references, considered singly or in combination, discloses the limitations of independent claim 7 regarding (a) a plurality of mechanical devices *associated with conversation elements*; (b) a memory, coupled to the plurality of mechanical devices, for storing a plurality of internal conversation elements, each internal conversation element representing an *audible utterance* to be transmitted to a remote listener in an *ongoing conversation*; (c) a processor, coupled to the memory and the plurality of mechanical devices, the processor for *generating an audible utterance in response to a user selection* of a mechanical device from the plurality of mechanical devices; and (d) wherein the processor, in response to user interaction with the *plurality* of mechanical devices is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Similarly, none of the cited references, considered singly or in combination, discloses the limitations of independent claim 13 regarding (a) a plurality of mechanical devices associated with conversation elements; (b) a memory, coupled to the plurality of mechanical devices, for storing a plurality of internal conversation elements, each internal conversation element representing an audible utterance to be transmitted to a remote listener in an ongoing conversation; (c) a processor, coupled to the memory and the plurality of mechanical devices, the processor for generating an

audible utterance in response to a user selection of a mechanical device from the plurality of mechanical devices; and (d) wherein the processor, in response to user interaction with the plurality of mechanical devices is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Moreover, with respect to the rejections of all currently pending claims, The Final Office Action and the Advisory Action cite no motivation to combine the references. The Final Office Action and the Advisory Action provide *benefits* for combining the references, but demonstrates no motivation, either explicit or implicit, in any of these references for combining them. Also, the Final Office Action and the Advisory Action appear to use impermissible hindsight in reaching its conclusions regarding obviousness.

Applicants respectfully note that while it may or may not be, as repeatedly suggested by the Final Office Action (p. 2, 4th para.; p. 4, 2nd para; and p. 7, last para.), “notoriously well known in the art to put a call on hold during the call reception or during the middle of a call and then deactivating the quiet mode to talk to a caller,” this suggestion is irrelevant to the inventive elements of the current claims. The current claims are not directed to putting a call on hold during the call reception or during the middle of a call and then deactivating a quiet mode to talk to a caller, as when a caller is on hold, by definition only one live person is present and no conversation can occur. By contrast, the current claims are directed to a method and system for generating audible utterances in response to user input during a *live, real time, two-way* phone conversation.

In light of the above, claims 1-7 and 9-13 are allowable.

Respectfully submitted,

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